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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,542	11/19/1999	FARZAN RASTINEJAD	PC10228A	7363

23913 7590 04/26/2002

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EXAMINER

GOLDBERG, JEROME D

ART UNIT	PAPER NUMBER
1614	10

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/443,542	RASTINEJAD ET AL.
	Examiner	Art Unit
	Jerome D Goldberg	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 March 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 24 and 26-35 is/are pending in the application.
 - 4a) Of the above claim(s) 1-8 and 24 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15&17.
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Art Unit: 1614

al
Claims 1-8 and 24 withdrawn from further consideration pursuant to 37 CFR
1.142(b) as being drawn to a nonelected invention, there being no allowable generic or
linking claim. Election was made **without** traverse in Paper No. 9.

1,8 and
Applicants elected without traverse in Paper No. 9., claim¹ 24 is now required to
be canceled.

Applicants', further, elected the compound X of Group I and the treatment of
cancer. Cancellation of the non-elected subject matter from the other claims is now
required. Claims 26-35 are still being examined as they read on the application of
compound ~~X~~ (as set forth in Figure 2).

Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, because the
specification, while being enabling for the specific cancers disclosed, does not
reasonably provide enablement for the term "cancer". The specification does not
enable any person skilled in the art to which it pertains, or with which it is most nearly
connected, to use the invention commensurate in scope with these claims. The term
"cancer" in claims 26-35 lacks clear exemplary support in the specification as filed.

Applicants' remarks and the publications are noted but the limited number of
examples set forth will not support such a broad term. Changing the term to the specific
cancers disclosed would overcome this rejection.

Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, because the
specification, while being enabling for the specific organic non-peptide compound
disclosed and elected by applicants, does not reasonably provide enablement for the
term "organic non-peptide compound". The specification does not enable any person

skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The term "organic non-peptide compound" in claims 26-35 lacks clear exemplary support. Applicants' remarks are noted but the limited number of examples set forth will not support such a broad term.

Moreover, the O'Connor et al reference cited by:

Applicants in Paper No. 15 shows that this term can include well known anticancer agents such as "agents included in this class were (a) DNA cross-linking agents such as cisplatin, carboplatin, nitrogen mustard, and thiotepa; (b) DNA/RNA antimetabolites, such as 5-fluorouracil and methotrexate; (c) topoisomerase I inhibitors, such as camptothecin, and (d) topoisomerase II inhibitors, such as adriamycin" (page 4296, col. 1, lines 40-45 after Figure). Clearly, the term is so broad as to include compounds that are not disclosed in the specification.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermone Goldberg whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday to Thursday 9 AM to 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



JEROME D. GOLDBERG
PRIMARY EXAMINER

Goldberg/LR
April 24, 2002